



UNITED STATES DEPARTMENT OF COMMERCE

Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

08/777,246 12/31/96 OISHI

K 35.G1868

005514 LMC1/0605  
FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK NY 10112

EXAMINER

LAUFER, F

ART UNIT	PAPER NUMBER
----------	--------------

2766

DATE MAILED: 06/05/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**Office Action Summary**

Application No. <b>08/777,246</b>	Applicant(s) <b>Kazuomo Oishi</b>
Examiner <i>703 306 4160</i> Pinchus M. Laufer	Group Art Unit <b>2766</b>

Responsive to communication(s) filed on 27 Mar 2000

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

**Disposition of Claims**

Claim(s) 1-20, 26, and 27 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1-20, 26, and 27 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

**Application Papers**

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 6 and 7

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

### **Part III DETAILED ACTION**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### *Docketing*

2. Please note that the application has been redocketed to a different examiner. Please refer all future communications regarding this application to the examiner of record, using the information supplied in the final section of the office action.

#### *Information Disclosure Statement*

3. Copies of the Information Disclosure Statements filed 27 January 1998 (Paper No. 6) and 23 February 1998 (Paper No. 7) bearing the signature of the previous examiner of record are included with this Office action since the record is unclear as to whether they had been previously acknowledged.

#### *Observation With Respect to Claim Language*

4. Examiner notes that the claims present functional recitations that do not further narrow the apparatus claims because they present intended use or intended outcome recitations.

Examiner notes that apparatus claims must be structurally distinguishable from the prior art. Claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See *In re Danley*, 120 USPQ 528, 531 (CCPA 1959). "Apparatus claims cover what a device is, not what a device does". See *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. See, *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

#### *Claim Rejections - 35 U.S.C. § 112*

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-13, and 26-27 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 6: the limitation "means for storing .. which is stored in an external device and fed from the external device" is unclear. Is this means part of the external device or is it a storage area which stores a piece of data which originally resides in the external device?

Claims 10 and 26-27: limitation "(b)" is unclear. These limitations suffer from the same ambiguity as described above.

Furthermore, (for all the aforementioned claims) as written it is unclear whether the external device forms part of the claimed invention.

*Claim Rejections - 35 U.S.C. § 103*

7. The previous action is incorporated by reference in its entirety. Particularly, the specific indication of various claim elements which will not be reiterated in this action.

8. Claims 1-20, and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friedman in view of Davies

**Applicant argues** (page 4, last paragraph) (a) that Friedman does not teach means for generating a signature etc. and (b) (page 5 paragraph 2) that Davies does not use both the input information and the secret information in generating the output.

**Response:** Friedman teaches using a key supplied from a module and the image information to generate a digital signature which uniquely identifies the image so as to guarantee image integrity and authenticity. Davies is relied upon solely for the teaching of storing the key on a module separate from the processing device. When this teaching is used to modify Friedman the claimed system is achieved.

*Response to Amendment*

9. Applicant's arguments filed 27 March 2000 have been fully considered but they are not persuasive. See the remarks which accompany the rejections.

*Conclusion*

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Information Regarding Communication with the PTO***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pinchus M. Laufer whose telephone number is (703) 306-4160. The examiner can normally be reached on weekdays from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, G. O. Hayes, can be reached on (703) 305-9711. The fax phone number for this Group is (703) 308-9051.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800.

June 1, 2000

*Pinchus M. Laufer*  
**Pinchus M. Laufer**  
**Primary Examiner**  
**Art Unit 2766**